

## **REMARKS**

### **Claim Rejections**

Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipic (U.S. 2,237,883) in view of Planin (U.S. 2,952,462). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipic in view of Planin and further in view of Kaplan et al. (U.S. 5,261,848). Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipic in view of Planin and further in view of Horiuchi (U.S. 5,301,444). Claims 11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipic in view of Planin and further in view of Spector (U.S. 5,897,418). Claims 14-16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldman (U.S. 2,498,074) in view of Spector and Keough (U.S. 5,350,058). Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldman in view of Spector and Keough and further in view of Horiuchi.

It is noted that the references to Lipic, Planin, and Keough were initially cited by the Examiner in the outstanding Final Office Action. Thus, this Amendment represents Applicant's initial opportunity to respond to the rejections based upon these references.

### **Drawings**

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed with this application on November 28, 2003 and July 14, 2004.

### **Claim Amendments**

By this Amendment, Applicant has canceled claims 13 and 19 and has amended claims 8 and 14 of this application. The subject matter of cancelled claims 13 and 19 is now included in claims 8 and 14. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Lipic teaches an ornamental device including a chamber (4) filled with a liquid and containing an object (5, 5a, 5b).

On page 4 of the outstanding Office Action, the Examiner admits that Lipic does not teach "at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior, and at least one decorative sticker connected to a surface of the body, and at least one ornament connected to an interior surface of the body."

Lipic does not teach at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

The secondary reference to Planin teaches a toy expandable from a compressed state to an expanded state when exposed to water.

Planin does not teach a body having an enclosed transparent outer shell; the body having a hollow interior for holding water; the body having a water inlet located on an outer surface of the transparent shell and communicating with the hollow interior; the body having a sealing cap removably connected to and sealing the water inlet; the body having a carrying handle connected thereto; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; nor does Planin teach at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

The secondary reference to Kaplan discloses a toy with a liquid-filled shell including a figure (14), a base (12), and a housing (16) removable located on the base. The housing includes an inner transparent shell portion (36), an outer transparent shell portion (38), and an enclosed cavity (40) filled with a liquid (42) with reflective particles (46).

Kaplan et al. do not teach a pen; a body connected to a top of the pen; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; each of the at least one expandable toy includes a weight located at a predetermined location; at least one decorative sticker connected to a surface of the body; at least

one ornament connected to an interior surface of the body; a body having a carrying handle connected thereto; nor does Kaplan et al. teach at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

The secondary reference to Horiuchi discloses a swimming toy fish including a liquid vessel (1) with a background plate (6), and a swimming toy fish (20) with an air tank (22) and a magnetic member (23).

Horiuchi does not teach a pen; a body connected to a top of the pen; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; each of the at least one expandable toy is connected to a surface of the hollow interior of the body; at least one decorative sticker connected to a surface of the body; at least one ornament connected to an interior surface of the body; a body having a carrying handle connected thereto; nor does Horiuchi teach at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

The secondary reference to Spector discloses a test tube doll package including an expandable figure (F) located in a test tube (T) under a vacuum. When a stopper (19) of the test tube is removed, thereby moving the vacuum, the figure will expand. Spector teaches a decorative label (20) adhered to either an interior or an exterior of a side of the test tube, but does not suggest at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

Spector does not teach a pen; a body connected to a top of the pen; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; each of the at least one expandable toy includes a weight located at a predetermined location; at least one ornament connected to an interior surface of the body; a body having a carrying handle connected thereto; nor does Spector teach at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

The secondary reference to Keough teaches a chambered enclosure for maintaining a toy in a dry condition and is cited for teaching a handle (38).

Keough does not teach the body having a water inlet located on an outer surface of the transparent shell and communicating with the hollow interior; the body having a sealing cap removably connected to and sealing the water inlet; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; nor does Keough teach at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

The secondary reference to Feldman discloses a method of making novelty displays including prepare an expandable resin body, inserting the expandable resin body into a container, and expanding the expandable resin body within the container.

Feldman does not teach a pen; a body connected to a top of the pen; a body having a sealing cap removably connected to and sealing the water inlet; each of the at least one expandable toy is connected to a surface of the hollow interior of the body; each of the at least one expandable toy includes a weight located at a predetermined location; at least one decorative sticker connected to a surface of the body; at least one ornament connected to an interior surface of the body; a body having a carrying handle connected thereto; nor does Feldman teach at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

Even if the teachings of Lipic, Planin, Kaplan et al., Horiuchi, Spector, Keough, and Feldman, and were combined, as suggested by the Examiner, the resultant combination does not suggest: at least one ornament connected to and protruding upwardly from an interior surface of a bottom of the body, the at least one ornament being spaced apart from side surfaces of the body.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which

allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Lipic, Planin, Kaplan et al., Horiuchi, Spector, Keough, or Feldman that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Lipic, Planin, Kaplan et al., Horiuchi, Spector, Keough, nor Feldman disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

**Summary**

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claims 13 and 19, thereby rendering moot the outstanding rejections under 35 U.S.C. § 103.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: February 17, 2005

By:

  
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